

**REMARKS**

Claims 2, 3, 6, 9 through 19, 21 through 35, 37 through 47 and 49 through 84 are currently pending in the application, of which claims 2, 3, 6, 9 through 19, 28 through 35, 37 through 47 and 49 through 84 are currently under examination. Claims 21 through 27 and 49 through 83 are withdrawn from consideration as being drawn to a non-elected invention, and Claims 1, 4, 5, 7, 8, 20, 36 and 48 have been canceled. No claims have been amended by this paper. Applicants respectfully request reconsideration of the application as amended herein.

**Rejections under 35 USC § 103(a):**

Claims 2, 3, 6, 9-19, 28-35, 37-47, and 84 stand rejected under 35 USC § 103(a) as obvious over US Patent No. 6,331,311 to Brodbeck et al. ('311) in view of US Patent No. 6,130,200 to Brodbeck et al. ('200); Penco et al., Polymer International 46:203-216 (1998) ("Penco"); and Ravivarapu et al., Eur J Pharm and Biopharm 50:263-270 (2000) ("Ravivaparu"). Applicants traverse this rejection.

Applicants submit that the Office's prima facie case of obviousness is **fatally flawed with respect to the motivation** to modify the '311 document as suggested by the Office.

It is important to note that Ravivaparu teaches the value of two polymers each with differing molecular weights **only for microparticles**. Ravivaparu does not teach or suggest applying this concept to any other application, including other pharmaceutical dosage forms such as injectable depot gels.

It is also important to note that '311 does not contain any teachings or suggestions of using microparticle technology in the inventive compositions that comprise an injectable depot gel.

Therefore, the only place that the Office could have found a teaching or suggestion of combining these two references is from reading the invention of the Applicants. **This represents use of impermissible hindsight in reconstructing the Applicants' invention.**

The conclusion of impermissible hindsight is reinforced upon a closer scientific examination of the art.

Microparticles are relatively solid particles that are typically spherical in shape. There is minimal solvent within the polymer-containing portion of the microparticles. Thus, microparticles' release characteristics can be dominated by size and polymer composition.

In contrast, for instance, injectable depot gels include solvents that have a significant and often unpredictable impact on polymeric behavior and thus drug release. Injectable depot gels, when administered to a patient, may have a variety of shapes, other than just spherical. Further, the nature of the drug release controlling mechanisms changes drastically between microspheres and injectable depot gels, based on the significant difference in depot sizes – microparticle sizes are measured in microns, while injectable depot gels are measured in tens of millimeters.

Thus one of ordinary skill would note the existence of Ravivaparu with respect to microparticles, but would not seriously think of routinely applying its teachings to injectable depot gels. To do so would ignore the unpredictable effects of the scientific variables present in injectable depot gels but not found in microparticles, such as solvent effects, shapes and sizes of the depots. The results of the combination of '311 and Ravivaparu would simply be unpredictable to one of ordinary skill, and thus non-obvious.

In order to form a proper *prima facie* case of obviousness, the Office must establish a motivation to combine the cited references. MPEP § 2143.01. Failure to establish this motivation using acceptable scientific reasoning supports the failure to establish a proper *prima facie* case of obviousness. Accordingly, Applicants request the withdrawal of the rejection of

claims 2, 3, 6, 9-19, 28-35, 37-47, and 84 under 35 USC § 103(a) as obvious over ‘311 ‘200, Penco and Ravivarapu.

**CONCLUSION**

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding rejections. Early notice to that effect is earnestly solicited.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact Applicants' Attorney at (408) 777-4914.

Respectfully submitted,

DIRECT CORPORATION



---

David J. Abraham  
Reg. No.: 39,554  
Direct: (408)777-4914

Date: 18 Sept. 08

2 Results Way  
Cupertino, CA 95014  
Phone: (408) 777-1417  
Fax: (408)777-3577